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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,034	10/20/2004	Heinz-Peter Rink	PAT-01033	2212
26922	7590	05/03/2006	EXAMINER	
BASF CORPORATION 1609 BIDDLE AVENUE WYANDOTTE, MI 48192			TESKIN, FRED M	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 05/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/512,034

Applicant(s)

RINK ET AL.

Examiner

Fred M. Teskin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 5-7 is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The reply of September 16, 2005 having been entered, claims 1-3, 5-7 and 9 remain pending and under examination.

Applicant's arguments, see pages 4-6, filed September 16, 2005, with respect to Mezger and Clouet et al have been fully considered and are persuasive. In this regard, the submission from *Kirk-Othmer* is cited as evidence of the reaction of an organic isocyanate and a thioalcohol (thiol) yielding a thiocarbamate product diverse from the dithiocarbamates and thiocarbamate-functional polymers taught by Mezger and Clouet et al, respectively (*viz.*, RNHC(O)SR' ; see, submission, p. 12, third full paragraph). The rejection of claims 1-3 and 5-7 has been withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over US 2396997 to Fryling.

The basis of the rejection is adequately set forth in the prior Office action and that explanation is incorporated herein by reference.

Applicants' arguments filed September 16, 2005 have been fully considered but they are not persuasive of error in the repeated rejection.

Applicants argue, in essence, that Fryling's disclosure does not suggest the particular structures of applicants' thiocarbamates resulting from the reaction of thiols and isocyanate functional compounds (Reply, p. 9).

The difficulty with this position is that, while claim 1 has been amended to require a reaction product of an organic compound containing at least one isocyanate group and at least one thiol, claim 9 is not so limited. Instead, the latter *independent* claim (represented in original form) merely requires regulating free-radical (co)polymerization of at least one olefinically unsaturated monomer by adding a thiocarbamate-functional organic compound to the (co)polymerization. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants do not dispute that Fryling teaches the polymerization of unsaturated organic compounds in the presence of sulfur-containing *modifiers* of polymerization (p. 1, ll. 33+ of right-hand column) and exemplifies the polymerization of various ethylenically unsaturated monomers in the presence of putative free-radical initiators (e.g., hydrogen peroxide and benzoyl peroxide per Examples 1 and 4). Moreover, applicants acknowledge the disclosure of *thiocarbamates* on page 3 of Fryling (Reply, p. 9, fourth paragraph), but urge that such disclosure does not disclose or suggest the particular structure of applicants' thiocarbamates resulting from the reaction of thiols and isocyanate functional compounds.

Such reaction is not, however, a limitation of claim 9, which merely calls for adding a thiocarbamate-functional compound to the free-radical (co)polymerization of at

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least one olefinically unsaturated monomer. Thiocarbamate-functional compounds are admittedly disclosed by Fryling and the examiner's rationale for adding such modifier compound to the Fryling polymerization, as expressed in the prior action, has not been challenged.

Accordingly, the continued rejection of claim 9 is still deemed tenable and therefore must be maintained.

Claims 1-3 and 5-7 are allowable over the prior art of record.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is


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(571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FMTeskin/04-28-06


FRED TESKIN
PRIMARY EXAMINER
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